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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,814	10/18/2001	Randal Scott	6424-61326	1777

7590

02/17/2005

KLARQUIST SPARKMAN, LLP

One World Trade Center

Suite 1600

121 S.W. Salmon Street

Portland, OR 97204

EXAMINER

ANANTHANARAYANAN, RAMYA

ART UNIT

PAPER NUMBER

2131

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/035,814

Applicant(s)

SCOTT, RANDAL

Examiner

Ramya Ananthanarayanan

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on October 18, 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-94 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2131

1. Claims 1-94 have been examined.

Specification

2. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 6, 7, 9, 10, 14-18, 27, 33, 35-39, 41, 48, 49, 51, 52, 54, 57, 73, 76, and 94 are rejected under 35 U.S.C. 102(e) as being anticipated by Holden (U.S. Patent 6,640,211).

Art Unit: 2131

5. With respect to claim 1, Holden discloses a genomic profile information system accessible over a communications network (column 2, lines 39-44), the genomic profile information system comprising:

Data for a plurality of participants indicating genomic profile information of the participants (column 1, lines 56-57); and

A software system comprising privacy settings for at least one of the participants and controlling access by others over the communications network to genomic profile information of the participant, wherein the participant controls the privacy settings for the participant, and the privacy settings for the participant can be configured by the participant over the communications network (column 1, lines 36-44).

With respect to claim 2, Holden discloses a system wherein the software system enforces confidentiality for the genomic profile information of the participant unless otherwise specified by the participant (column 5, lines 50-51).

With respect to claim 6, Holden discloses a system wherein the privacy settings comprise separate privacy settings for other participants and for researchers (column 1, lines 42-44).

With respect to claim 7, Holden discloses a system wherein the privacy settings comprise separate privacy settings indicating whether medical information of the participant can be accessed by others (column 1, lines 36-44).

Art Unit: 2131

With respect to claim 9, Holden discloses a system wherein the privacy settings comprise separate privacy settings indicating whether a primary disease of the participant can be accessed by others (column 3, lines 35-40, lines 53-58).

With respect to claims 10, 14, 15, and 16 Holden discloses a system wherein:

The settings indicate whether a participant's genomic profile information can be examined by other participants (column 2, lines 56-65); and

The software system accordingly allows examination of the participant's genomic profile information by other participants while preserving anonymity of the participant (column 3, lines 53-58; column 5, lines 50-51).

With respect to claim 17, Holden discloses a system wherein the settings indicate whether a participant's genomic profile information can be distributed (column 2, lines 60-65).

With respect to claim 18, Holden discloses a system wherein the settings indicate an organization to which a participant's genomic profile information can be distributed (column 2, lines 60-65).

With respect to claim 27, Holden discloses a genomic profile information system wherein the genomic profile information comprises genomic pathology information for one or more participants (column 4, lines 50-52: Pathology is the study of disease, and genomic pathology is a study of disease at the genomic level.).

Art Unit: 2131

With respect to claim 33, Holden discloses a method comprising:

Registering an individual as a participant in a genomic profile information center (column 1, lines 28-35);

Collecting personal genomic profile data of the participant (column 1, lines 28-35);

Adding the participant to a genomic profile information database (column 1, lines 28-35);

and

Granting the participant custodial control over the participant's genomic profile information (column 2, lines 60-65).

With respect to claim 35, Holden discloses a method wherein custodial control comprises controlling, via a computer user interface, whether the participant's genomic profile information is to be provided to others (column 2, lines 56-65).

With respect to claim 36, Holden discloses a method wherein custodial control comprises controlling, via a computer user interface, whether the participant's genomic profile information is to be provided for use in a particular study (column 2, lines 56-65).

With respect to claim 37, Holden discloses a method wherein custodial control comprises controlling whether other participants being members of a designated group can access the participant's genomic profile information (column 2, lines 56-65).

Art Unit: 2131

With respect to claim 38, Holden discloses a method wherein the participant's genomic profile information is identified anonymously (column 5, lines 59-61).

With respect to claim 39, Holden discloses a method further comprising:

As a result of receiving authorization from the participant to provide the participant's genomic profile information for use in research, compensating the participant (column 2, lines 56-65).

With respect to claims 41, 52, and 57, Holden discloses a method comprising:

Analyzing a biological sample collected from a patient to generate a genomic profile for the patient (column 1, lines 28-35);

Incorporating the genomic profile for the patient into a genomic profile information collection comprising genomic profile information for a plurality of other patients (column 1, lines 28-35); and

Compensating the patient by providing at least some level of access to the genomic profile information collection (column 2, lines 56-65).

With respect to claims 48, 49, and 51, Holden discloses a genomic profile information center granting patients control over their personal genomic profiles (column 1, lines 28-35; column 2, lines 56-65).

Art Unit: 2131

With respect to claim 54, Holden discloses a method wherein the information is contributed by providing a personal biological specimen from the person (column 1, lines 28-35).

With respect to claim 73, Holden discloses a method of providing a personal genomic information service to a participant, the method comprising:

Obtaining information and a biological sample from the participant to generate a personal genomic profile (column 1, lines 28-35); and

Granting the participant the ability to perform custodial functions on the profile (column 2, lines 56-65).

With respect to claim 76, Holden discloses a method wherein the custodial functions comprise:

Sharing an anonymous version of the personal genomic profile with other participants (column 5, lines 59-61).

With respect to claim 94, Holden discloses a genomic profile information center comprising:

Means for collecting personal genomic profiles from a plurality of participants (column 1, lines 28-35);

Means for pooling the personal genomic profiles into a collection of personal genomic profiles (column 1, lines 28-35); and

Means for recording compensation due to a participant as a result of having sold the collection to a requesting entity (column 2, lines 56-65).

Art Unit: 2131

Claims 77 and 78 are rejected under 35 U.S.C. 102(e) as being anticipated by Bisbee et al. (U.S. Patent 6,237,096).

With respect to claim 77, Bisbee et al. disclose a method comprising:

Signing a contract over the Internet establishing ownership of personal genomic profile information (column 13, lines 7-15).

With respect to claim 78, Bisbee et al. disclose a method comprising:

Accepting a contract signature over the Internet establishing ownership of personal genomic profile information (column 13, lines 7-15).

Claims 63 and 64 are rejected under 35 U.S.C. 102(e) as being anticipated by Weschler, Jr. (U.S. Patent 6,757,720).

With respect to claim 63, Weschler, Jr. discloses a method comprising:

Storing a personal genomic profile for a participant in a database (column 4, lines 47-49);

Designating the participant as a member of a group (column 11, lines 60-66); and

Providing the participant with access to group functions and information (column 11, line 67 to column 12, line 1).

With respect to claim 64, Weschler, Jr. discloses a method wherein the group functions include exchanging information with other group members (column 9, lines 30-37).

Art Unit: 2131

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 11, 13, 21, 25, 28-32, 34, 40, 46, 50, 53, 56, 58, 59, 60-62, 68-72, 74, 75, 79-88, and 90-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holden (U.S. Patent 6,640,211) in view of Huff (U.S. Patent 6,670,731).

Holden and Huff are analogous art because both are in the field of electronic communication.

With respect to claim 8, Holden discloses the limitations set forth in claim 1, upon which claim 8 is dependent. Additionally, Holden discloses a genomic profile information system wherein:

The privacy settings comprise separate privacy settings indicating whether group membership information of the participant in the system can be accessed by others (column 2, lines 56-65).

Holden does not disclose the system wherein:

The software system indicates whether the participant is a member of one or more groups.

Huff discloses the system wherein:

The software system indicates whether the participant is a member of one or more groups (column 12, lines 67: family is considered to be a distinct group.).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Huff with the teachings of Holden in order to make and store links between data items (column 4, lines 36-39).

With respect to claim 11, Holden discloses the limitations set forth in claim 10, upon which claim 11 is dependent.

Holden also discloses a genomic profile information system wherein:

The settings indicate whether a participant's genomic profile information can be examined by other participants who are members of the group (column 2, lines 56-65); and

The software system accordingly allows examination of the participant's genomic profile information while preserving anonymity of the participant (column 5, lines 59-61).

Holden does not disclose a system wherein:

The settings indicate one or more participants are members of a group.

Huff discloses a system wherein:

The settings indicate one or more participants are members of a group (column 12, lines 67).

Art Unit: 2131

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

With respect to claim 13, Holden discloses the limitations set forth in claim 1, upon which claim 13 is dependent.

Holden does not disclose a genomic profile information system wherein:

The settings comprise an identifier by which a participant can be identified anonymously; and

The software system accordingly identifies the participant via the identifier.

Huff discloses a genomic profile information system wherein:

The settings comprise an identifier by which a participant can be identified anonymously (column 17, lines 5-6, 49-56); and

The software system accordingly identifies the participant via the identifier (column 17, lines 5-6, 49-56).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Huff with the teachings of Holden in order to track royalties due and sequencing of the participants (column 17, lines 52-56).

With respect to claim 21, Holden discloses the limitations of claim 1, upon which claim 21 is dependent.

Holden does not disclose a genomic profile information system further comprising:

A comparison tool software system comprising comparison tools for comparing genomic profile information for two or more participants.

Huff discloses a genomic profile information system of claim 1 further comprising:

A comparison tool software system comprising comparison tools for comparing genomic profile information for two or more participants (column 4, lines 5-7: In order to discover common ancestry, the two profiles must be compared.).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Huff with the teachings of Holden in order to discover common linkage between persons in the database (column 4, lines 5-7).

With respect to claim 25, Holden discloses a genomic profile information system wherein the participants are listed anonymously (column 5, lines 59-61).

Holden does not disclose a system wherein comparison tools provide comparison results indicating one or more participants, and the participants are listed in the comparison results.

Huff discloses a system wherein comparison tools provide comparison results indicating one or more participants, and the participants are listed in the comparison results (column 5, lines 35-38).

Art Unit: 2131

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

With respect to claims 28-32, Holden discloses the limitations set forth in claim 1, upon which claims 28-32 are dependent.

Holden does not disclose a system wherein the system has information for over 10,000, 100,000, 1,000,000, 10,000,000, or 100,000,000 participants.

Huff discloses a system has information for over 10,000, 100,000, 1,000,000, 10,000,000, or 100,000,000 participants (column 4, lines 63-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Huff with the teachings of Holden in order to permit incorporation of existing large data collections (column 4, lines 15-18).

With respect to claim 34, Holden discloses the limitations set forth in claim 33, upon which claim 34 is dependent.

Holden does not disclose a computer-readable medium comprising computer-executable instructions for performing the method of claim 33.

Huff discloses a computer-readable medium comprising computer-executable instructions for performing the method of claim 33 (column 4, lines 29-56).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Huff with the teachings of Holden in order to provide efficient access to the data (column 15, lines 19-21).

With respect to claim 40, Holden discloses the limitations set forth in claim 39, upon which claim 40 is dependent.

Holden does not disclose a method wherein compensation originates from payment by a third party.

Huff discloses a method wherein compensation originates from payment by a third party (column 7, lines 59-61; column 8, lines 6-8).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Huff with the teachings of Holden in order to pay them the amount that they have earned (column 17, lines 55-56).

With respect to claims 46 and 59, Holden discloses a method comprising:

Registering an individual as a participant in a genomic profile information network (column 1, lines 28-35);

Art Unit: 2131

Collecting genomic profile information from the participant, wherein the genomic profile information from the participant comprises gene expression information for one or more genes based on a biological sample taken from the participant (column 1, lines 28-35);

Adding the genomic profile information from the participant to a collection of data comprising genomic profile information from other participants, wherein the genomic profile information from the other participants comprises gene expression information for the one or more genes based on biological samples taken from the other participants (column 1, lines 28-35); and

Presenting the genomic profile information of the one or more other participants, wherein identities of the one or more other participants remain anonymous (column 5, lines 59-61).

Holden does not disclose a method comprising:

Comparing the genomic profile information of the participant with that from the other participants to generate comparison results indicating closeness between the participant's genomic profile information and genomic profile information of one or more of the other participants.

Huff discloses a method comprising:

Comparing the genomic profile information of the participant with that from the other participants to generate comparison results indicating closeness between the participant's genomic profile information and genomic profile information of one or more of the other participants (column 5, lines 35-38).

Art Unit: 2131

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

With respect to claim 50, Holden does not disclose a method comprising:

Collecting personal genomic profile information from thousands of remote participants.

Huff discloses a method comprising:

Collecting personal genomic profile information from thousands of remote participants (column 24, line 1).

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

With respect to claim 53, Holden does not disclose a method wherein proceeds for compensating the person come from sale of the information to an entity requesting the information from an information center.

Huff discloses a method wherein proceeds for compensating the person come from sale of the information to an entity requesting the information from an information center (column 7, lines 59-61; column 8, lines 6-8).

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

Art Unit: 2131

With respect to claims 55 and 56, Holden discloses a method comprising:

Directing a person to supply a biological sample from the person's body to a laboratory (column 1, lines 28-35);

Receiving an analysis of the biological sample from the laboratory and incorporating the analysis into a personal genomic profile for the person (column 1, lines 28-35);

Pooling the personal genomic profile with personal genomic profiles from other people into a collection of anonymous personal genomic profiles (column 5, lines 59-61).

Holden does not disclose a method comprising:

Selling the collection of anonymous pooled personal genomic profiles to a requesting entity for payment; and

As a result of the sale, compensating the person via the payment.

Huff discloses a method comprising:

Selling the collection of anonymous pooled personal genomic profiles to a requesting entity for payment (column 7, lines 59-61; column 8, lines 6-8); and

As a result of the sale, compensating the person via the payment (column 7, lines 59-61; column 8, lines 6-8).

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

Art Unit: 2131

With respect to claim 58, Holden discloses method for motivating a participant to contribute to a genomic profile information database, the method comprising:

At the direction of the participant, receiving personal genomic profile information of the participant for addition to the database (column 1, lines 28-35).

Holden does not disclose a method comprising:

Providing monetary compensation to the participant in exchange for receiving the personal genomic profile information of the participant.

Huff discloses a method comprising:

Providing monetary compensation to the participant in exchange for receiving the personal genomic profile information of the participant (column 7, lines 59-61; column 8, lines 6-8).

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

With respect to claim 60, Holden discloses a method wherein receiving personal genomic profile information of the participant comprises:

Receiving genotype information of the participant (column 4, lines 38-40); and

Receiving phenotype information of the participant (column 4, lines 43-46; column 5, lines 46-49).

Art Unit: 2131

With respect to claim 61, Holden does not disclose a method, further comprising:

Receiving payment for a collection of genomic profile information comprising the individual genomic profile information;

Wherein the monetary compensation is derived from the payment.

Huff discloses a method, further comprising:

Receiving payment for a collection of genomic profile information comprising the individual genomic profile information (column 7, lines 59-61; column 8, lines 6-8);

Wherein the monetary compensation is derived from the payment (column 7, lines 59-61; column 8, lines 6-8).

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

With respect to claim 62, Holden discloses a method, further comprising:

Combining the individual genomic profile information into a collection of genomic profile information comprising the individual genomic profile information (column 1, lines 28-35).

Holden does not disclose a method, further comprising:

Selling the collection of genomic profile information comprising the individual genomic profile information in exchange for a payment;

Wherein the monetary compensation is derived from the payment.

Art Unit: 2131

Huff discloses a method, further comprising:

Selling the collection of genomic profile information comprising the individual genomic profile information in exchange for a payment (column 7, lines 59-61; column 8, lines 6-8);
Wherein the monetary compensation is derived from the payment (column 7, lines 59-61; column 8, lines 6-8).

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

With respect to claim 68, Holden does not disclose a method for presenting analysis of a set of personal genomic profiles, the method comprising:

Designating a set of personal genomic profiles;

Identifying differences and similarities in the set of personal genomic profiles; and

Displaying the differences and similarities in the set of personal genomic profiles.

Huff discloses a method for presenting analysis of a set of personal genomic profiles, the method comprising:

Designating a set of personal genomic profiles (column 5, lines 58-60);

Identifying differences and similarities in the set of personal genomic profiles (column 5, lines 58-60); and

Displaying the differences and similarities in the set of personal genomic profiles (column 5, lines 62-67).

Art Unit: 2131

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Huff with the teachings of Holden in order to discover common linkage between persons in the database (column 4, lines 5-7).

With respect to claim 69, Holden discloses a method wherein the displaying generates a web page for viewing by participant who has provided information for a personal genomic profile in the set (column 3, lines 18-21).

With respect to claim 70, Holden discloses a method for building a genomic profile information database, the method comprising:

Responsive to the request of an individual human being, adding a personal genomic profile for the individual human being to the database (column 1, lines 28-35); and

Responsive to the request to provide a collection of information comprising the personal genomic profile, providing an anonymous version of the personal genomic profile from the database to the requestor (column 5, lines 59-61).

Holden does not disclose a method comprising:

Receiving a request to provide a collection of information comprising the personal genomic profile to a requestor in exchange for payment;

Responsive to the request to provide a collection of information comprising the personal genomic profile, providing version of the personal genomic profile from the database to the requestor in exchange for payment; and

Art Unit: 2131

Based on having provided the anonymous personal genomic profile to the requestor, compensating the individual human being for having added the personal genomic profile via the payment.

Huff discloses a method comprising:

Receiving a request to provide a collection of information comprising the personal genomic profile to a requestor in exchange for payment (column 7, lines 59-61; column 8, lines 6-8);

Responsive to the request to provide a collection of information comprising the personal genomic profile, providing the personal genomic profile from the database to the requestor in exchange for payment (column 7, lines 59-61; column 8, lines 6-8); and

Based on having provided the personal genomic profile to the requestor, compensating the individual human being for having added the personal genomic profile via the payment (column 7, lines 59-61; column 8, lines 6-8).

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

With respect to claim 71, Holden discloses a method for providing a service to a remote customer, the method comprising:

Obtaining a personal genomic profile of the customer (column 1, lines 28-35); and

Pooling the profile with other profiles (column 5, lines 59-61).

Art Unit: 2131

Holden does not disclose a method comprising:

Selling the pool; and

Passing compensation back to the customer.

Huff discloses a method comprising:

Selling the pool (column 7, lines 59-61; column 8, lines 6-8); and

Passing compensation back to the customer (column 7, lines 59-61; column 8, lines 6-8).

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

With respect to claim 72, Holden discloses a method for providing a service to a remote customer, the method comprising:

Obtaining a personal genomic profile of the customer (column 1, lines 28-35);

Pooling the profile with other profiles (column 5, lines 59-61);

Holden does not disclose a method comprising:

Over a computer network connection, providing the customer with tools to compare the profile with other profiles in the pool.

Huff discloses a method comprising:

Over a computer network connection, providing the customer with tools to compare the profile with other profiles in the pool (column 4, lines 5-7).

Art Unit: 2131

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

With respect to claim 74, Holden discloses the limitations set forth in claim 73, upon which claim 74 is dependent. Holden does not disclose a method wherein the custodial functions comprise:

Selling the personal genomic profile.

Huff discloses a method wherein the custodial functions comprise:

Selling the personal genomic profile (column 7, lines 59-61; column 8, lines 6-8).

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

With respect to claim 75, Holden discloses the limitations set forth in claim 73, upon which claim 75 is dependent. Holden does not disclose a method wherein the custodial functions comprise:

Comparing the personal genomic profile with personal genomic profiles of other participants.

Huff discloses a method wherein the custodial functions comprise:

Comparing the personal genomic profile with personal genomic profiles of other participants (column 4, lines 5-7).

Art Unit: 2131

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

With respect to claim 79, Holden discloses a method comprising:

Offering a collection of anonymous genomic profiles (column 5, lines 69-71).

Holden does not disclose a method of acquiring personal genomic profile information for use in a research study, the method comprising:

Offering payment for a collection of genomic profiles.

Huff discloses a method of acquiring personal genomic profile information for use in a research study, the method comprising:

Offering payment for a collection of genomic profiles (column 7, lines 59-61; column 8, lines 6-8).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Huff with the teachings of Holden in order to pay them the amount that they have earned (column 17, lines 55-56).

With respect to claim 80, Holden discloses a method of selling personal genomic profile information, the method comprising:

Offering an anonymous version of one's personal genomic profile (column 5, lines 59-61).

Holden does not disclose a method of selling personal genomic profile information, the method comprising:

Offering a version of one's personal genomic profile in exchange for payment.

Huff discloses a method of selling personal genomic profile information, the method comprising:

Offering a version of one's personal genomic profile in exchange for payment (column 7, lines 59-61; column 8, lines 6-8).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Huff with the teachings of Holden in order to pay them they amount that they have earned (column 17, lines 55-56).

With respect to claim 81, Holden discloses a method of selling personal genomic profile information, the method comprising:

Providing an anonymous version of one's personal genomic profile to be pooled with the personal genomic profile of others (column 5, lines 59-61).

Holden does not disclose a method comprising:

Authorizing via a computer user interface over a communications network a sale of the pooled personal genomic profile in exchange for payment; and

Accepting a portion of the payment.

Huff discloses a method comprising:

Art Unit: 2131

Authorizing via a computer user interface over a communications network a sale of the pooled personal genomic profile in exchange for payment (column 7, lines 59-61; column 8, lines 6-8; column 17, lines 56-62); and

Accepting a portion of the payment (column 7, lines 59-61; column 8, lines 6-8).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Huff with the teachings of Holden in order to pay them they amount that they have earned (column 17, lines 55-56).

With respect to claim 82, Holden discloses a method of selling personal genomic profile information, the method comprising:

Contributing an anonymous version of one's personal genomic profile to a pool (column 5, lines 59-61).

Holden does not disclose a method comprising:

In exchange for payment, contributing an version of one's personal genomic profile to a pool to be sold in exchange for payment.

Huff discloses a method comprising:

In exchange for payment, contributing an version of one's personal genomic profile to a pool to be sold in exchange for payment (column 7, lines 59-61; column 8, lines 6-8).

Art Unit: 2131

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Huff with the teachings of Holden in order to pay them the amount that they have earned (column 17, lines 55-56).

With respect to claim 83, Holden discloses a method of providing a genomic profile information clearinghouse, the method comprising:

At the direction of the individual, accepting personal genomic profile information about the individual (column 1, lines 28-35).

Holden does not disclose a method comprising:

Establishing a trust relationship with an individual;

Conducting a sale of the personal genomic profile information about the individual to a third party; and

Paying the individual from proceeds of the sale.

Huff discloses a method comprising:

Establishing a trust relationship with an individual (column 17, lines 56-62);

Conducting a sale of the personal genomic profile information about the individual to a third party (column 7, lines 59-61; column 8, lines 6-8); and

Paying the individual from proceeds of the sale (column 7, lines 59-61; column 8, lines 6-8).

Art Unit: 2131

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Huff with the teachings of Holden in order to pay them the amount that they have earned (column 17, lines 55-56).

With respect to claim 84, Holden discloses a method of providing a genomic profile information clearinghouse, the method comprising:

Receiving personal genomic profile information from an individual (column 1, lines 28-35).

Holden does not disclose a method comprising:

Providing the genomic profile information to a third party in exchange for payment; and
Providing a portion of the payment to the individual.

Huff discloses a method comprising:

Providing the genomic profile information to a third party in exchange for payment
(column 7, lines 59-61; column 8, lines 6-8); and

Providing a portion of the payment to the individual (column 7, lines 59-61; column 8, lines 6-8).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Huff with the teachings of Holden in order to pay them the amount that they have earned (column 17, lines 55-56).

Art Unit: 2131

With respect to claim 85, Holden discloses a method of providing a genomic profile information clearinghouse, the method comprising:

Receiving personal genomic profile information from an individual (column 1, lines 28-35);

Combining the personal genomic profile information into a pool of genomic profile information (column 1, lines 28-35).

Holden does not disclose a method comprising:

Providing the pool to a third party in exchange for payment; and

Providing a portion of the payment to the individual.

Huff discloses a method comprising:

Providing the pool to a third party in exchange for payment (column 7, lines 59-61; column 8, lines 6-8); and

Providing a portion of the payment to the individual (column 7, lines 59-61; column 8, lines 6-8).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Huff with the teachings of Holden in order to pay them they amount that they have earned (column 17, lines 55-56).

With respect to claim 86, Holden discloses a method wherein identities of the plurality of persons remains anonymous. Holden does not disclose a method of presenting information from

Art Unit: 2131

a genomic profile information database having a plurality of entries for a plurality of persons, wherein the entries indicate traits of the persons, the method comprising:

Finding persons having common traits in the database;

Displaying a graphical representation of the persons having common traits,

Huff discloses a method comprising:

Finding persons having common traits in the database (column 5, lines 58-60); and

Displaying a graphical representation of the persons having common traits (column 5, lines 62-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Huff with the teachings of Holden in order to .

With respect to claim 87, Holden discloses a computer-readable medium having computer-executable instructions for performing the following:

Receiving personal genomic profile information for an individual (column 1, lines 28-35);

Adding the personal genomic profile information to a database (column 1, lines 28-35).

Holden does not disclose a computer-readable medium having computer-executable instructions for performing the following:

Retrieving a pool of information from the database;

Receiving an indication that the pool of information has been sold; and

Art Unit: 2131

Responsive to receiving the indication, recording compensation data indicating the individual is to be compensated.

Huff discloses a computer-readable medium having computer-executable instructions for performing the following:

Retrieving a pool of information from the database (column 5, lines 35-38);

Receiving an indication that the pool of information has been sold (column 17 lines 66-67 to column 18, lines 1-3); and

Responsive to receiving the indication, recording compensation data indicating the individual is to be compensated (column 18, lines 4-7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Huff with the teachings of Holden in order to pay them the amount that they have earned (column 17, lines 55-56).

With respect to claim 88, Holden discloses a computer-readable medium wherein receiving the profile information comprises receiving the profile information over a computer network connection (column 2, lines 43-45).

With respect to claim 90, Holden discloses a computer-readable medium wherein the indication is received over a computer network connection (column 2, lines 43-45).

Art Unit: 2131

With respect to claim 91, Holden does not disclose a computer-readable medium wherein the pool of information from the database is a set of personal genomic profiles having specified criteria.

Huff discloses a computer-readable medium wherein the pool of information from the database is a set of personal genomic profiles having specified criteria (column 5, lines 35-38).

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

With respect to claim 92, Holden does not disclose a computer-readable medium further comprising computer-readable instructions for performing the following:

Receiving the specified criteria from a researcher; and

Presenting a number of individuals meeting the criteria to the researcher.

Huff discloses a computer-readable medium further comprising computer-readable instructions for performing the following:

Receiving the specified criteria from a researcher (column 7, lines 59-61); and

Presenting a number of individuals meeting the criteria to the researcher (column 7, lines 59-61).

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

With respect to claim 93, Holden discloses a genomic profile information center comprising:

Art Unit: 2131

A collection of personal genomic profiles for a plurality of participants (column 1, lines 55-57).

Holden does not disclose a center comprising:

Tools for comparing the personal genomic profiles with a genomic profile of a particular participant.

Huff discloses a center comprising:

Tools for comparing the personal genomic profiles with a genomic profile of a particular participant (column 4, lines 5-7).

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holden (U.S. Patent 6,640,211) in view of Bisbee et al. (U.S. Patent 6,237,096).

Holden and Bisbee et al. are analogous art because both are in the field of electronic communication.

With respect to claim 5, Holden discloses the limitations set forth in claim 1, upon which claim 5 is dependent.

Art Unit: 2131

Holden does not disclose a genomic profile information system wherein identity of the participant is authenticated over the communications network via biometric screening. Bisbee et al. disclose a genomic profile information system wherein identity of the participant is authenticated over the communications network via biometric screening (column 5, lines 25-28).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Bisbee et al. with the teachings of Holden in order to provide non-repudiation of the applicant's authentication, as is well known in the art.

Claims 3, 4, and 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holden (U.S. Patent 6,640,211) in view of Weschler, Jr. (U.S. Patent 6,757,720).

Holden and Weschler, Jr. are analogous art because both are in the field of electronic communication.

With respect to claim 3, Holden discloses the genomic profile information system of claim 1.

Holden does not disclose the system wherein:

The settings indicate a computer system under a participant's control on which at least some of the participant's genomic profile information resides; and

The software system accordingly directs requests for information residing on the computer system under the participant's control to the computer system under the participant's control.

Art Unit: 2131

Weschler, Jr. discloses the system wherein:

The settings indicate a computer system under a participant's control on which at least some of the participant's genomic profile information resides (column 1, lines 50-56); and

The software system accordingly directs requests for information residing on the computer system under the participant's control to the computer system under the participant's control (column 1, lines 38-41).

It would have been obvious to one of ordinary skill in the art to have combined the teachings of Weschler, Jr. with the teachings of Holden in order to provide an easier implementation of user-by-user storage location direction and extensibility to access, retrieve, and use profile information for a new user (column 2, lines 19-24).

With respect to claim 4, Holden discloses the genomic profile information system of claim 1.

Holden does not disclose the system wherein at least some of the participant's genomic profile information residing on a computer system under the participant's control is provided to another participant via a peer-to-peer network arrangement.

Weschler, Jr. discloses the system wherein at least some of the participant's genomic profile information residing on a computer system under the participant's control is provided to another participant via a peer-to-peer network arrangement (column 6, lines 38-40).

Art Unit: 2131

The motivational benefits of combining the teachings of Weschler, Jr. and Holden are stated above.

With respect to claim 42, Holden discloses the genomic profile information system of claim 41.

Holden does not disclose the system wherein the genomic profile information collection comprises a network of computers communicating via a peer-to-peer network arrangement.

Weschler, Jr. discloses the system wherein the genomic profile information collection comprises a network of computers communicating via a peer-to-peer network arrangement (column 6, lines 38-40).

The motivational benefits of combining the teachings of Weschler, Jr. and Holden are stated above.

With respect to claim 43, Holden discloses the genomic profile information system of claim 41.

Holden does not disclose the system wherein incorporating comprises storing a reference to a computer under control of the patient at which genomic profile information for the patient can be accessed.

Weschler, Jr. discloses the system wherein incorporating comprises storing a reference to a computer under control of the patient at which genomic profile information for the patient can be accessed (column 1, lines 50-52).

The motivational benefits of combining the teachings of Weschler, Jr. and Holden are stated above.

With respect to claim 44, Holden discloses the genomic profile information system of claim 41.

Holden does not disclose the system wherein the genomic profile for the patient is stored on a computer system under control of the patient and accessed by others by accessing the computer system under control of the patient.

Weschler, Jr. discloses the system wherein the genomic profile for the patient is stored on a computer system under control of the patient and accessed by others by accessing the computer system under control of the patient (column 1, lines 50-56).

The motivational benefits of combining the teachings of Weschler, Jr. and Holden are stated above.

With respect to claim 45, Holden discloses the genomic profile information system of claim 41.

Holden does not disclose the system wherein the genomic profile for the patient is stored on a computer system under control of the patient and access to the genomic profile for the individual is provided by the computer system under control of the patient.

Art Unit: 2131

Weschler, Jr. discloses the system wherein the genomic profile for the patient is stored on a computer system under control of the patient and access to the genomic profile for the individual is provided by the computer system under control of the patient (column 1, lines 50-56).

The motivational benefits of combining the teachings of Weschler, Jr. and Holden are stated above.

Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holden (U.S. Patent 6,640,211) in view of Eberhardt (U.S. Patent 5,659,741).

Holden, Huff and Eberhardt are all analogous art because all are in the field of electronic communication.

With respect to claim 19, Holden discloses the limitations set forth in claim 1, upon which claim 19 is dependent.

Holden does not disclose a genomic profile information system wherein a set of participants have a disease condition, and the genomic profile information comprises information indicating the outcomes of such therapies (column 3, lines 63-67; column 4, lines 30-34).

Art Unit: 2131

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Eberhardt with the combined teachings of Holden and Huff in order to decrease the need for expensive diagnostic tests (column 3, lines 1-3).

With respect to claim 20, Holden discloses the limitations set forth in claim 1, upon which claim 20 is dependent.

Holden does not disclose a genomic profile information system wherein the genomic profile information system further comprises comparison tools operable by a researching participant having a disease condition, and the tools identify therapy outcomes for participants having a disease condition and molecular portrait similar to the researching participant (column 3, lines 63-67; column 4, lines 30-34).

The motivational benefit of combining the teachings of Eberhardt with those of Holden and Huff are stated above.

Claims 22, 24, 65-67, and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holden (U.S. Patent 6,640,211) and Huff (U.S. Patent 6,760,731) in view of Eberhardt (U.S. Patent 5,659,741).

Art Unit: 2131

With respect to claim 22, Holden and Huff disclose the limitations set forth in claim 21, upon which claim 22 is dependent. Holden discloses patient-driven analyses of genomic profile information (column 4, lines 32-33).

Holden does not disclose a genomic profile information system wherein the participant is a patient having a disease condition, and the comparison tools support comparative analyses of genomic profile information over a communications network.

Eberhardt discloses a system wherein the participant is a patient having a disease condition, and the comparison tools support comparative analyses of genomic profile information over a communications network (column 3, lines 63-67; column 4, lines 30-34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Eberhardt with the combined teachings of Holden and Huff in order to decrease the need for expensive diagnostic tests (column 3, lines 1-3).

With respect to claim 24, Holden and Huff disclose the limitations set forth in claim 21, upon which claim 24 is dependent.

Holden does not disclose a genomic profile information system wherein at least one of the tools compares drug response information.

Eberhardt discloses a system wherein at least one of the tools compares drug response information (column 3, lines 63-67; column 4, lines 30-34).

The motivational benefit of combining the teachings of Eberhardt with those of Holden and Huff are stated above.

With respect to claim 65, Holden and Huff disclose the limitations set forth in claim 63.

Holden and Huff do not disclose a method further comprising:

Limiting members of the group to those interested in acquiring information about a particular medical condition.

Eberhardt discloses a method further comprising:

Limiting members of the group to those interested in acquiring information about a particular medical condition (column 8, lines 39-41).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Eberhardt with the combined teachings of Holden and Huff in order to

With respect to claim 66, Holden and Huff disclose the limitations set forth in claim 63.

Holden and Huff do not disclose a method further comprising:

Limiting members of the group to those having a particular medical condition.

Eberhardt discloses a method further comprising:

Art Unit: 2131

Limiting members of the group to those having a particular medical condition (column 8, lines 30-34).

The motivational benefit of combining the teachings of Eberhardt with those of Holden and Huff are stated above.

With respect to claim 67, Holden and Huff disclose the limitations set forth in claim 63.

Holden and Huff do not disclose a method further comprising:

Limiting members of the group to those having substantially similar age, sex, or race.

Eberhardt discloses a method further comprising:

Limiting members of the group to those having substantially similar age, sex, or race (column 16, lines 15-18).

The motivational benefit of combining the teachings of Eberhardt with those of Holden and Huff are stated above.

With respect to claim 89, Holden and Huff disclose the limitations set forth in claim 88, upon which claim 89 is dependent.

Holden does not disclose a genomic profile information system wherein receiving the profile information comprises receiving the profile information from a remote laboratory.

Art Unit: 2131

Eberhardt discloses a system wherein receiving the profile information comprises receiving the profile information from a remote laboratory (column 10, line 50).

The motivational benefit of combining the teachings of Eberhardt with those of Holden and Huff are stated above.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holden (U.S. Patent 6,640,211) and Huff (U.S. Patent 6,670,731) in view of Adams (U.S. Patent 5,966,711).

Holden, Huff and Adams are analogous art because both are in the field of electronic communication.

With respect to claim 23, Holden and Huff disclose the limitations of claim 21.

Holden and Huff do not disclose a genomic profile information system wherein at least one of the tools compares gene expression.

Adams discloses a genomic profile information system wherein at least one of the tools compares gene expression (column 5, lines 28-33; column 6, lines 9-10).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Adams with the teachings of Holden and Huff in order to simplify maintaining database heterogeneity and process synchronization (column 5, lines 25-27).

Art Unit: 2131

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holden (U.S. Patent 6,640,211) in view of Huff (U.S. Patent 6,670,731) and further in view of Shapiro et al. (U.S. Patent 6,714,944).

Holden, Huff and Shapiro et al. are analogous art because both are in the field of electronic communication.

With respect to claim 12, Holden discloses the genomic profile information system of claim 1. Additionally, Holden discloses the ability maintain anonymity of the participant (column 5, lines 59-61).

Holden does not disclose a system further comprising:

Software for identifying two or more participants having similar genomic profile information; wherein the identifying software presents a user interface option to a participant for contacting another similar participant.

Huff discloses a system further comprising:

Software for identifying two or more participants having similar genomic profile information (column 5, lines 58-60).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Huff with the teachings of Holden in order to discover common linkage between persons in the database (column 4, lines 5-7).

Huff does not disclose a system further comprising:

Wherein the identifying software presents a user interface option to a participant for contacting another similar participant.

Shapiro et al. disclose a system further comprising:

Wherein the identifying software presents a user interface option to a participant for contacting another similar participant (column 8, lines 58-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Shapiro et al. with the combined teachings of Holden and Huff in order to distribute documents to various third parties (column 8, lines 51-53).

Claims 26 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holden (U.S. Patent 6,640,211) and Huff (U.S. Patent 6,670,731) in view of Shapiro et al. (U.S. Patent 6,714,944).

Holden, Huff and Shapiro et al. are analogous art because both are in the field of electronic communication.

With respect to claim 26, Holden and Huff disclose a genomic profile information system of claim 25. Additionally, Holden discloses anonymous listings of the participant (column 5, lines 59-61).

Holden and Huff do not disclose a system wherein at least one of the participants can be selected by a computer user interface to send a message to the participant.

Shapiro et al. disclose a system wherein at least one of the participants can be selected by a computer user interface to send a message to the participant (column 8, lines 58-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Shapiro et al. with the combined teachings of Holden and Huff in order to distribute documents to various third parties (column 8, lines 51-53).

With respect to claim 47, Holden and Huff disclose the limitations set forth in claim 46.

Holden and Huff do not disclose a method further comprising:

Accepting a selection via a graphical user interface from the participant indicating a message is to be sent to the one or more other participants; and

Responsive to the selection, sending a message to the one or more other participants.

Shapiro et al. disclose a method further comprising:

Accepting a selection via a graphical user interface from the participant indicating a message is to be sent to the one or more other participants (column 8, lines 63-67 to column 9, lines 1-6); and

Responsive to the selection, sending a message to the one or more other participants (column 9, lines 20-21).

Art Unit: 2131

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Shapiro et al. with the combined teachings of Holden and Huff in order to distribute documents to various third parties (column 8, lines 51-53).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramya Ananthanarayanan whose telephone number is (571) 272-5860. The examiner can normally be reached on Monday through Friday, 8:30 -5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RA



ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER